

Appl. No. 09/929,995
Amdt. Dated February 17, 2006
Reply to Office Action of November 17, 2005
Docket No.: 12078-142

REMARKS/ARGUMENTS

The Office Action of November 17, 2005 has been carefully reviewed and this response addresses the Examiner's concerns stated in the Office Action. All objections and rejections are respectfully traversed.

I. STATUS OF THE CLAIMS

Claims 1, 3-20, and 22-46 are pending in the application.

Claims 2 and 21 were previously cancelled without prejudice.

Claim 43 is rejected under 35 U.S.C. § 112, first and second paragraphs.

No rejection is stated for claim 34. Applicants therefore assert that claim 34 contains allowable subject matter.

Claim 46 has been withdrawn from consideration because of a constructive restriction requirement.

Claims 1, 3-20, 22-33, and 35-45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hendrey et al, United States Patent # 6,647,269, issued on November 11, 2003, filed on July 5, 2001, published on August 1, 2002, priority date August 7, 2000 (Hendrey), in view of Weiss et al., United States Patent # 6,738,951, issued on May 18, 2004, filed on December 9, 1999.

II. DRAWING OBJECTION UNDER 37 C.F.R. § 1.83(a)

On pages 2-3, in paragraph 1, the Office Action states that the drawings are objected to under 37 C.F.R. § 1.83(a) because they fail to show "display 129" as described in the specification on page 52, paragraph [00153]. Applicants have herein amended the specification, paragraph [00153] to provide the correct reference number.

III. RESTRICTION REQUIREMENT UNDER 37 C.F.R. § 1.142(b)

On page 3, in paragraph 2, the Office Action states that newly submitted claim 46 is directed to an invention that is independent or distinct from the invention originally claimed. The Office Action states that Invention I, claims 1, 3-20, and 22-45, is directed to class 709 subclass 218, using interconnected networks, and that Invention II, claim 46 is directed to class 709 subclass 207, priority based messaging. The Office Action states that since Applicants have received an action on the merits for the Invention I, this invention has been constructively elected for prosecution on the merits and claim 46 is withdrawn from consideration.

Applicants respectfully maintain that claims 1, 3-20, and 22-46 are directed to the same invention and should be examined together since the inventions of Group I and Group II are so closely related as to justify an examination of all of the claims as a single invention. Furthermore, it is well established that restriction is not mandatory merely because the claims may be directed to divergent subject matter. The fact that two methods, or a method and an apparatus, may be searched in different subclasses is not seen to be a material factor, at least insofar as the restriction requirement for the claimed invention is concerned. In fact, according to MPEP § 803, "[I]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent and distinct inventions." In light thereof, it is believed that an action on the merits of claims 1, 2-20, and 22-46 in a single application is in order. In view of the foregoing discussion, Applicant submits that the requirement for restriction is improper and should be withdrawn.

IV. REJECTION UNDER 35 U.S.C. § 112, FIRST AND SECOND PARAGRAPHS

On page 4, in paragraph 2, the Office Action states that claim 43 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement, and that the specification does not support how can data be received from eye movement. The Office Action states that claim 43 is also rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention because, the Office Action states, it is not clear how can data be gathered using eye movement.

Applicants respectfully point out that eye movement technology was well known in the art at the time the priority document and present application were filed, August 15, 2000, and August 15, 2001, respectively. In particular, both Hutchinson, United States Patent # 4,836,670, issued June 6, 1989 (attached), and Kahn, United States Patent # 5,844,544, issued December 1, 1998 (attached), disclose eye movement technology. In the Georgia Institute of Technology Institutional Repository, Haro et al. published a paper in 1999 entitled *Detecting and Tracking Eye by Using Their Physiological Properties (GIT-GVU-99-46)* (attached). Therefore, eye movement technology was well-known in the art at the time Applicants filed the priority document and the present application, although collecting eye movement data in the context of Applicants' claimed invention is novel and therefore patentable because no reference has been cited herein that discloses Applicants' claimed invention. Applicants have herein amended the specification (paragraph [00153]) to explicitly refer to eye movement detectors as conventional. For the convenience of the Examiner, Applicants have provided copies of the above mentioned documents. Applicants therefore assert that the rejections under 35 U.S.C. § 112, first and second paragraphs, are inappropriate and should be withdrawn.

V. REJECTION UNDER 35 U.S.C. § 103(a)

On pages 5-15, in paragraph 3, the Office Action states that claims 1, 3-20, and 22-45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hendrey in view of Weiss.

In order for a rejection under 35 U.S.C. §103 to be sustained, the Office Action must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Further, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching,

suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Applicants assert that there is no suggestion or motivation in Hendrey or Weiss to perform the claimed subject matter of independent claims 1, 19, 25, 29, and 35 (upon which dependent claims 3-18 and 20-45 depend), and that Applicants' invention is not made obvious by Hendrey or Weiss or their combination at least because:

(1) Applicants claim advertising information formatted outside the client device that contains data entry information indicating purchasing options, and that advertising information is used to determine, by the client device, a response to the advertising information (independent claim 1). In the system of Hendrey, on the contrary, the mobile unit simply receives the advertisement and its location is tracked, but the mobile unit receives no data entry information, and does not determine a response to the advertising information;

(2) Neither Hendrey nor Weiss, either separately or in combination, disclose Applicants' claimed formatting, outside the client device, unsolicited advertising information into XML elements (independent claim 1). Hendrey doesn't disclose Applicants' claimed formatting at all, and Weiss receives XML documents, but does not format received documents into XML format;

(3) Applicants' claim a method including the step of sending, by the client device, the user data to the service provider (independent claim 25), but there is no communication path described in Hendrey from the mobile unit to the store;

(4) Applicants claim relating, by the client device, the information extracted from the advertisement to user-specific data in the client device (Applicants' independent claim 35), whereas Hendrey states that any relationship between the advertisement and user-specific data is performed in the tracking system, not the mobile unit (client device) (Hendrey, col. 4, lines 26-44);

(5) Applicants claim wherein the service provider data is displayed using a plug-in cooperatively associated with the service information, and wherein the plug-in further comprises information about a preference of the user (dependent claims 27 and 41), whereas Hendrey

makes no mention of the use of plug-ins, and because Hendrey determines user preferences in the tracking system, not the mobile unit; and

(6) Applicants claim a method including the steps of displaying the service provider data on a wearable device and receiving user data from eye movement (dependent claim 43), but Hendrey does not disclose receiving any user data, including user data from eye movement.

(7) Hendrey and Weiss cannot be combined because Hendrey would not operate as intended (independent claim 1 and dependent claims 20, 30, and 36).

The following arguments are organized by cited passages in Hendrey and Weiss. Claims that were rejected based on a particular cited passage are argued together. A summary of the passages cited and the claims argued with respect to those passages follows:

| Cited Passage | Page in OA containing rejections | Claim(s) |
|---|----------------------------------|--|
| Hendrey, col. 2, lines 14-29 | 5, 8-14 | 1, 11, 19, 25, 29, 35 |
| Hendrey, col. 2, lines 30-40 | 5 | 1 |
| Hendrey, col. 2, line 57 -- col. 3, line 33 | 5-13, 15 | 1, 3-10, 12-19, 22-25, 27, 29, 32, 33, 37-45 |
| Weiss, Abstract | 6, 10, 12, 14 | 1, 20, 30, 36 |
| Hendrey, col. 5, lines 12-32 | 11 | 25, 26 |
| Hendrey, col. 4, lines 46-61 | 11, 13 | 25, 31 |
| Hendrey, Abstract | 11 | 28 |

In summary, Applicants assert that independent claims 1, 19, 25, 29, and 35 are not made obvious by Hendrey and Weiss for the reasons stated below. Further, Applicants assert that claims 3-18, 20, 22-24, 26-28, 30-34, and 36-45 are patentable at least by virtue of their dependence upon allowable independent claims 1, 19, 25, 29, and 35.

On pages 5 and 8-14 of the Office Action, with respect to independent claims 1, 19, 25, 29, and 35, and dependent claim 11, and cited passage Hendrey, col. 2, lines 14-29,

(1) The Office Action states that Hendrey teaches a method for distributing utilizing an advertisement for a service for accessing a service, the service being relevant to a location to a client device at the location, said method comprising the steps of formatting, outside the client device, unsolicited advertising information from the advertisement, the unsolicited advertising information including (Hendrey discloses an advertisement received by a mobile device): service information indicating the purpose of the advertisement (Hendrey discloses mobile device enters the area of a corresponding to a certain business) (independent claim 1);

(2) The Office Action states that Hendrey teaches the method of claim 6 wherein the user reply is sent directly from the client device to received at a point-of-presence (POP) (dependent claim 11);

(3) The Office Action states that Hendrey teaches a method for conveying unsolicited information comprising the steps of preparing the unsolicited information by a service including service information indicating the purpose of the information, data entry information indicating purchasing options based on the purpose, and formatting the unsolicited information in the transmitter for transmission to a client device operating within a context associated with the transmitter (independent claim 19);

(4) The Office Action states that Hendrey teaches a method for interacting with a service provider comprising the steps of receiving an unsolicited broadcast message having user-specific service information about a service from a service provider into a client device (independent claim 25);

(5) The Office Action states that Hendrey teaches a method of utilizing executable code in a transmitter for providing an advertisement to a client device, said method comprising the steps of receiving the advertisement by the executable code in the transmitter from a service provider about a service offered by the service provider, and formatting the advertisement by the executable code in the transmitter for transmission to the client device operating within a coverage area of the transmitter (independent claim 29); and

(6) The Office Action states that Hendrey teaches a method of utilizing executable code in a client device receiving an unsolicited, formatted advertisement from a transmitter located outside the client device, said method comprising the steps of receiving the unsolicited, formatted advertisement from an infrared communication signal conveyed from the transmitter, wherein the transmitter formatted the advertisement, and arriving at a communication interface associated with the client device, the unsolicited, formatted advertisement containing at least a portion of a service offered by a service provider (Hendrey discloses an advertisement received by a mobile device), decoding, in the client device, the unsolicited, formatted advertisement to extract information contained therein (Hendrey discloses an advertisement received by a mobile device), relating, by the client device, the information to user-specific data in the client device, and displaying, by the client device, the information related to the user-specific data to a user of the client device (Hendrey discloses an advertisement received by a mobile device) (independent claim 35).

In the cited passage (Hendrey, col. 2, lines 14-29), Hendrey states a method for tracking a mobile unit and sending the mobile unit an advertisement when the mobile unit enters a geographic location near the business associated with the advertisement. As shown in Hendrey's FIG. 1, the mobile unit is tracked and the advertisement is sent by a system outside of the mobile unit itself which is not the business associated with the advertisement. Hendrey also states that the system tracks the mobile unit to determine if the mobile unit has entered the business in order to track the effectiveness of the advertisement.

With respect to independent claim 1 and the cited passage, Applicants claim formatting, outside the client device, unsolicited advertising information. Hendrey does not specify that there is formatting done, and thus does not specify where the formatting is done. Even if the assumption of the Office Action holds, i.e. that formatting is automatically done if an advertisement is sent, nowhere does Hendrey suggest where the formatting is done. Hendrey states that advertisement generation subsystem generates advertising content, creates an advertisement about a particular set of goods, generates an advertisement relevant to a proximately located business, or generates an advertisement for goods or services (Hendrey, col. 4, lines 29-55), but Hendrey nowhere discloses formatting the advertisement. Therefore, Hendrey does not make obvious Applicants' independent claim 1.

With respect to dependent claim 11, Applicants claim formatting user inputs, a response, and a portion of the unsolicited advertising information into a user reply that is sent from the client device to a POP, where the user reply makes user inputs available to the service. In other words, the client device is gathering user input, a response to the advertisement from the user, and a portion of the advertisement, putting them together, and sending them from the client device to a POP. Hendrey, however, automatically tracks the location of the mobile device, requiring no user input whatsoever to perform the tracking. Any information being emitted from the client device has to do with its location. There is no disclosure or suggestion in Hendrey to perform Applicants' claimed the step of formatting user inputs, a response, and a portion of the unsolicited advertising information into a user reply because no user inputs are accepted at the mobile unit. Further, nowhere does Hendrey disclose or suggest any explicit action taken by the mobile unit other than displaying the advertisement. The location information of Hendrey, no matter how broadly interpreted, is not Applicants' claimed portion of the advertising information. At most, Hendrey discloses that the user could read the advertisement on the mobile unit, but nowhere does Hendrey disclose or suggest Applicants' claimed portion of the advertising information formatted into a user reply. Therefore, Hendrey does not make obvious Applicants' dependent claim 11.

With respect to independent claim 19 and the cited passage, Applicants claim a method for conveying unsolicited information including of data entry information indicating purchasing options based on the purpose. As previously stated, nowhere does Hendrey disclose or suggest data entry of any kind, including information indicating purchasing options. Even a broad interpretation of Hendrey's tracking of the mobile unit cannot include Applicants' claimed data entry information indicating purchasing options, because Hendrey's tracking simply includes location information, which does not encompass data entry information indicating purchasing options.

With further reference to independent claim 19, Applicants claim receiving the unsolicited information from the service into a transmitter outside the client device having a link layer and formatting the unsolicited information in the transmitter. Applicants' claim presents a system having three separate entities: a service, a transmitter, and a client device. In Applicants' system, the unsolicited information originates at the service, is received into a transmitter having

a link layer, is formatted in the transmitter, and is received by the client device. Hendrey discloses, on the contrary, a stationary unit and a mobile unit, with an optional link to a store. In Hendrey, the advertisement originates at the stationary unit, where Hendrey's content generator creates it, and is transmitted to the mobile unit. The stationary unit tracks the mobile unit and maintains statistics concerning its proximity to businesses associated with the advertisement. Thus, Hendrey does not make obvious Applicants' claimed step of receiving the unsolicited information from the service into a transmitter because the tracking system of Hendrey itself creates the advertisement, not the store. For this reason, Hendrey cannot make obvious Applicants' independent claim 19.

With still further reference to independent claim 19, Applicants claim formatting the unsolicited information (received from the service) in the transmitter for transmission to a client device. In other words, as stated previously, Applicants disclose three separate entities: service, transmitter, and client device. The transmitter, in Applicants' system, receives unsolicited information from the service, formats the information, and transmits it to the client device. As stated previously, Hendrey's tracking system "creates" and "generates" advertisements, and thus does not receive the advertisements from the store. Hendrey alludes to the purchase of advertisements by a business (Hendrey, col. 3, lines 56-62), but Hendrey does not state that the store sends advertisements to the tracking system. Hendrey states that the store "sends advertising content to a mobile telecommunications unit responsive to the location of the MU" (col. 3, line 66 – col. 4, line 1), but nowhere is that process described, and nowhere does Hendrey disclose Applicants' claimed process of sending the advertisements from the service to a transmitter outside the client device, and then on to the client. In fact, Hendrey teaches away from Applicants' claimed step by stating that Step 202 uses location-sensitive advertising content generation subsystem 131 to create a tailored advertising message responsive to the prospect's location, and send it via telecommunication infrastructure 120 to the prospect's MU 110" (col. 5, lines 26-30). Without any disclosure to the contrary, it is clear that Hendrey's tracking system does not receive advertisements, but instead creates them itself. Thus, Hendrey does not make obvious Applicants' independent claim 19.

With respect to independent claim 25 and the cited passage, Applicants claim receiving an unsolicited broadcast message from a service provider into a client device. Hendrey, on the

contrary, states that store 100 is only *optionally* connected to infrastructure 120 (col. 5, lines 10-11), and further states, as described elsewhere in this document, that the tracking system generates the advertisements. Thus, with only an optional connection between the store and the mobile unit, it is not clear how Hendrey could perform Applicants' claimed step of receiving an unsolicited broadcast message from a service provider into a client device. Instead, Hendrey goes to great lengths to discuss the creation/generation of advertisements in the tracking system. To a person of ordinary skill in the art, then, Hendrey has not explicitly or implicitly stated how content arrives from the store into the tracking system, and thus has not described Applicants' claimed unsolicited broadcast message that is sent from the service provider to the client device. Thus, Hendrey does not make obvious Applicants' independent claim 25.

With further reference to independent claim 25, Applicants claim the step of receiving, by the client device, user data into the service object which is created by the client device from service information. As stated previously, no user data is received at all in the mobile unit of Hendrey. The mobile unit is automatically being tracked for location and is displaying advertisements, but Hendrey does not disclose Applicants' claimed receiving, by the client device, user data. Further, Hendrey does not disclose any processing with respect to the advertisement other than displaying it. In particular, Hendrey does not disclose Applicants' claimed creating a service object in the client device from service information. For this reason, Hendrey cannot make obvious Applicants' independent claim 25.

With respect to independent claim 29, Applicants claim a method of utilizing executable code in a transmitter including the step of receiving an advertisement in the transmitter from a service provider. In other words, the transmitter of Applicants contains executable code that receives an advertisement from a service provider and transmits the advertisement (and conveys the advertisement to the client device). As stated above, Hendrey does not disclose or suggest a system such as Applicants' where the service provider (Hendrey's store) is generating advertisements, sending them to a transmitter (Hendrey's tracking system), where the transmitter sends them to the client device (Hendrey's mobile unit). Hendrey, in fact, teaches away from such a configuration by stating that advertisements are created/generated in the tracking system (Hendrey, col. 4, lines 27-32), and by stating that the link between the store and the

telecommunications system is optional. Thus, Hendrey cannot make obvious Applicants' independent claim 29.

With further reference to independent claim 29, Applicants claim formatting the advertisement in the transmitter. As stated previously, Hendrey does not disclose or suggest that the advertisement is formatted anywhere, and does not disclose or suggest Applicants' three active system components as described previously. The Office Action is assuming formatting of the advertisement, but cannot assume where the formatting is being accomplished, without any reference whatsoever in Hendrey to substantiate the assumption. Applicants explicitly claim formatting of the advertisement in the transmitter. Since Hendrey discloses no such step, , Hendrey cannot make obvious Applicants' independent claim 29.

With reference to independent claim 35, Applicants claim decoding, in the client device, the unsolicited, formatted advertisement. As the Office Action states, Hendrey simply states that an advertisement is received by the mobile unit. Applicants, on the contrary, claim that the advertisement is sent in a formatted state and is decoded by the client device. Applicants specifically state two steps that Hendrey does not explicitly disclose: formatting the advertisement outside of the client device and decoding the advertisement in the client device. The Office Action can only speculate that either of these steps is happening because Hendrey does not disclose them. Therefore, Hendrey cannot make obvious Applicants' independent claim 35.

With further reference to independent claim 35, Applicants claim relating, by the client device, the information extracted from the advertisement to user-specific data in the client device. The Office Action states that Hendrey simply discloses an advertisement received by a mobile device. Nowhere does Hendrey disclose or suggest processing that the mobile unit might perform other than receiving and displaying the advertisement. In particular, Hendrey does not disclose or suggest Applicants' claimed relating, by the client device, the information extracted from the advertisement to user-specific data in the client device because, in the system of Hendrey, any relationship between the advertisement and user-specific data is performed in the tracking system, not the mobile unit (Hendrey, col. 4, lines 26-44). Applicants assert that mere reception of an advertisement cannot imply either of Applicants' claimed extracting information

from the advertisement or relating that information to user-specific data in the client device. For these reasons, Hendrey cannot make obvious Applicants' independent claim 35.

On page 5, in paragraph 3, with respect to independent claim 1, the Office Action states that Hendrey discloses unsolicited advertising information including data entry information indicating purchasing options based on the purpose of the advertisement (Hendrey, col. 2, lines 30-40).

In the cited passage (Hendrey, col. 2, lines 30-40), Hendrey states conditions upon which the advertisement is considered to have failed, in particular, if the mobile unit doesn't enter the geographic location associated with the advertisement within a certain amount of time, and if the mobile unit moves to a geographic location that is over a certain distance from the geographic location associated with the advertisement. Hendrey further states that purchase information is written to a database when the user associated with the mobile device makes a purchase at the store (presumably the store associated with the advertisement).

Applicants claim advertising information formatted outside the client device that contains data entry information indicating purchasing options, and that advertising information is used to determine, by the client device, a response to the advertising information. In the system of Hendrey, there is no data entry disclosed with respect to the client device, and thus no data entry information necessary. Further, in Hendrey, the client device and the purchase can be coupled only if the store provides purchase information to the database maintained by the tracking system, not the client device. Applicants, on the contrary, claim that the client device itself determines a response to the advertising signal based on the advertising information which contains the data entry information. Thus, Hendrey cannot make obvious Applicants' independent claim 1.

On pages 5-13 and 15, with respect to claims 1, 3-10, 12-19, 22-25, 27, 29, 32, 33, and 37-45, and the cited passage, Hendrey, col. 2, line 57 -- col. 3, line 33,

(1) Independent claim 1, page 3: The Office Action states that Hendrey teaches a method including the step of formatting unsolicited advertising information including contact information containing instructions for enabling the client device to communicate with the service and forming an advertising signal containing the unsolicited advertising information (the Office Action states that Hendrey discloses system delivering advertisement to a mobile device);

(2) Dependent claim 3, pages 6-7: The Office Action states that Hendrey teaches a method including the step of selecting the service based on the unsolicited advertising information and the response;

(3) Dependent claim 4, page 7: The Office Action states that Hendrey teaches a method including the step of constructing a user interface for allowing the user to communicate with the client device;

(4) Dependent claim 5, page 7: The Office Action states that Hendrey teaches a method including the step of receiving user inputs in response to the unsolicited advertising information;

(5) Dependent claim 6, page 7: The Office Action states that Hendrey teaches a method including the step of formatting the user inputs, the response, and a portion of the unsolicited advertising information into a user reply, the user reply for making the user inputs available to the service;

(6) Dependent claim 7, page 7: The Office Action states that Hendrey teaches wherein the user reply is received at the transmitter;

(7) Dependent claim 8, page 7: The Office Action states that Hendrey teaches wherein the user reply is received as a wireless signal from the client device;

(8) Dependent claim 9, page 8: The Office Action states that Hendrey teaches wherein the user reply is received at the transmitter using a communication interface providing electromechanical contact between the client device and the transmitter;

(9) Dependent claim 10, page 8: The Office Action states that Hendrey teaches a method including the step of receiving a service response from the transmitter, the service response including executable code for allowing the client device to interact with the service;

(10) Dependent claim 12, page 8: The Office Action states that Hendrey teaches wherein the user reply is received over a personal digital assistant (PDA) interface providing electromechanical contact between the client device and the POP;

(11) Dependent claim 13, page 8: The Office Action states that Hendrey teaches the method including the step of receiving a service response from the POP, the service response including executable code for allowing the client device to interact with the service;

(12) Dependent claim 14, page 8: The Office Action states that Hendrey teaches wherein the advertisement is propagated as an optical signal through air;

(13) Dependent claims 15, 23, and 33, pages 8, 10, and 13: The Office Action states that Hendrey teaches wherein the optical signal (diffuse infrared signal) has a wavelength in the range of 850 nanometers to 1250 nanometers;

(14) Dependent claim 16, page 9: The Office Action states that Hendrey teaches wherein the transmitter receives the advertisement over an Internet;

(15) Dependent claim 17, page 9: The Office Action states that Hendrey teaches wherein the transmitter receives the advertisement over a fiber optic network;

(16) Dependent claim 18, page 9: The Office Action states that Hendrey teaches wherein the client device is a personal digital assistant (PDA);

(16) Independent claim 19, page 9: The Office Action states that Hendrey teaches a method including the steps of preparing unsolicited information by a service including contact information containing instructions for enabling the client device to communicate with the service, and conveying the unsolicited information from the transmitter to the client device over a communication medium;

(17) Dependent claims 22 and 32, pages 10 and 13: The Office Action states that Hendrey teaches wherein the unsolicited information (advertisement) is conveyed from the transmitter as a diffuse infrared signal;

(18) Dependent claim 24, page 10: The Office Action states that Hendrey teaches wherein the client device includes a client device physical layer and a client device link layer compatible with the link layer in the transmitter;

(19) Independent claim 25, pages 10-11: The Office Action states that Hendrey teaches a method including the step of sending, by the client device, the user data to the service provider;

(20) Dependent claims 27 and 41, pages 11 and 15: The Office Action states that Hendrey teaches wherein the information about the service (service provider data) is displayed to the user if the client device is running a plug-in cooperatively associated with the service;

(20) Independent claim 29, page 12: The Office Action states that Hendrey teaches a method of utilizing executable code in a transmitter including the step of conveying the advertisement by the executable code in the transmitter from the transmitter to the client device over a communication medium;

(21) Dependent claim 37, page 15: The Office Action states that Hendrey teaches wherein the unsolicited, formatted advertisement further comprises service information enabling the user to make a decision about the service, the decision based on the service information and data entry information informing the user about utilizing the service, and contact information containing instructions enabling the client device to communicate with the service provider;

(22) Dependent claim 38, page 15: The Office Action states that Hendrey teaches wherein the transmitter includes an emitter link layer;

(23) Dependent claim 39, page 15: The Office Action states that Hendrey teaches wherein the client includes a client device link layer;

(24) Dependent claim 40, page 15: The Office Action states that Hendrey teaches wherein the emitter link layer is compatible with the client device link layer.

(26) Dependent claim 42, page 15: The Office Action states that Hendrey teaches wherein the plug-in further comprises information about a preference of the user;

(27) Dependent claim 43, page 13: The Office Action states that Hendrey teaches the method including the steps of displaying the service provider data on a wearable device and receiving user data from eye movement;

(28) Dependent claim 44, page 13: The Office Action states that Hendrey teaches the method further comprising the step of displaying the service provider data on a device mounted in a vehicle and receiving information pertaining to the location of the vehicle through an IR communication interface;

(29) Dependent claim 45, page 15: The Office Action states that Hendrey teaches wherein the unsolicited information is conveyed from the transmitter as a radio frequency (RF) signal.

In the cited passage (Hendrey, col. 2, line 57 -- col. 3, line 25), Hendrey states that location information of the mobile unit is used to track the effectiveness of advertising by monitoring whether a user's behavior is altered based on the advertisement on the mobile unit. Criteria, such as the user's prompt reaction to the advertisement based on either the location information of the mobile unit or the user's purchase at the store, are used to determine the effectiveness of the advertisement. Hendrey states: "For example, if a store advertises a sale using a message sent to a wireless device, the advertisement may be considered effective if the

user visits the store and/or makes a purchase at the store . . .” Elsewhere in the disclosure, Hendrey clarifies the statement “if a store advertises a sale using a message sent to a wireless device” by descriptions such as that the location-sensitive advertising generation subsystem 131 generates advertising content relevant to the location of the user with respect to the store (Hendrey, col. 4, lines 28-32). Hendrey thus makes it clear that the store itself is not producing and sending an advertisement, but instead, the tracking system 105, which includes the location-sensitive advertising content generation subsystem 131, is determining the content of the advertisement, and creating and sending the advertisement, as well as tracking the user’s response based on the location of the mobile unit, but not based on any form of user entry into the mobile unit.

Hendrey also states, in the cited passage, that a stationary unit is a non-mobile telecommunication transmitter, transceiver, or receiver typically connected to the telecommunication infrastructure using wire or fiber links, including telephone, DSL, cable-modem, and other non-wireless modem or network connection. Hendrey further states that a mobile unit is a mobile telecommunication transmitter, transceiver, or receiver that is typically connected to the telecommunication infrastructure using wireless links, including cell phones, pages, wireless web browsers, PDAs, and laptop/handheld/wearable computers, and that a telecommunications unit is either a mobile unit or a stationary unit. In other words, the system of Hendrey is configured such that mobile units communicate with stationary units through the telecommunication system as shown in FIG. 1. Note that nowhere does Hendrey disclose that store 100 is a mobile or stationary unit, and, as previously stated, link 112 is optional. Therefore, Hendrey does not describe any communication between the mobile unit and the store.

In dependent claims 3-5, 7-9 and 12, Applicants make various claims about the user’s interface with the client device. In Hendrey, user interface to the mobile unit is simply that the user might be holding the mobile unit as the user moves from location to location. However, the response of the mobile unit to advertising is not linked to any explicit user entry as one skilled in the art would understand the term “user entry” to mean. For example, if the user throws the mobile unit of Hendrey into a store, but doesn’t actually go into the store herself, the tracking system of Hendrey would consider the advertisement effective even though the user never entered the store. Further, if someone other than the user of the mobile unit who was using the

user's credit card entered the store and made a purchase, the advertisement that was possibly seen by the user but not by the purchaser would be deemed effective. Thus it is clear from Hendrey's description that the location of the mobile unit can be decoupled from the actions of the user, which makes inconsistent the interpretation of Hendrey by the Office Action to include user entry. Hendrey defines a "user" to include an automated system that generates advertising content (Hendrey, col. 3, lines 44-46), but elsewhere describes the tracking system to be the user of the advertising content, not the mobile unit, because Hendrey describes all advertising to be generated and tracked by the tracking system. Thus, Hendrey does not make obvious Applicants' dependent claim 3 which states a method including the step of selecting the service based on the unsolicited advertisement *and the response* [Emphasis added], which is determined by the *client device* based on the unsolicited advertising because, in Hendrey, the mobile unit displays the advertisement, but does not receive Applicants' claimed response. Further, Hendrey does not make obvious Applicants' dependent claim 4 which states a method including the step of constructing a user interface to allow the user to communicate with the client device because nowhere does Hendrey disclose user entry in the client device requiring Applicant's claimed user interface. Still further, Hendrey does not make obvious Applicants' dependent claim 5 which is based on claims 3 and 4 and which states a method including the step of receiving user inputs because Hendrey does not receive user inputs at the client device as stated previously. Likewise, Hendrey does not make obvious Applicants' dependent claims 7-9 and 12 which state that the user reply is received at the transmitter, as a wireless signal from the client device, using a communication interface providing electromechanical contact between the client device and the transmitter, over a PDA interface providing electromechanical contact between the client device and the POP, because Hendrey does not disclose any way for a user reply to be formulated.

In independent claims 1, 19, 25, and 37, and dependent claims 6, 10, and 13, Applicants make various claims about the client device's interface with a transmitter and with the service. As stated previously, the sole mobile unit-initiated communication in Hendrey is location information. Neither does Hendrey disclose or suggest the mobile unit's taking any action specific to received advertising information, but instead performs the same steps with all advertisements. In particular, Hendrey does not make obvious Applicants' independent claim 1 which states the step of determining, by, the client device, a response to the advertising signal

based on the advertising information because the mobile unit of Hendrey simply presents all advertising information to the user without taking Applicants' further step of determining the response based on the advertisement itself. In Hendrey, any action based on the advertisement itself is managed by the tracking system, not the mobile unit.

Further, with respect to dependent claim 6 and independent claim 19, as shown previously, Hendrey does not disclose an interface between the mobile unit and the store, and thus cannot make obvious any of Applicants' claims to an interface between the client device and the service. In the alternative, if the Office Action is referring to the tracking system as the service provider, then Hendrey does not disclose Applicants' claimed transmitter, outside of the client device, to which the service provider sends in information, where the transmitter formats the information. In particular, Hendrey does not make obvious Applicants' claim 6 which states the step of formatting user inputs, the response, and a portion of the advertising into a user reply to make the user inputs available to the service because Hendrey neither receives user input from the user at the mobile unit, nor describes an interface between the mobile unit and the store. Nor does Hendrey make obvious Applicants' claim 19 which states the steps of preparing unsolicited information by a service, receiving the unsolicited information into a transmitter outside the client device, formatting the unsolicited information in the transmitter, and conveying the information from the transmitter to the client device because the formatting in Hendrey's system occurs in the tracking system which is in the stationary unit, not in Applicants' claimed transmitter which formats and conveys the information to the client device.

Likewise, Hendrey does not make obvious Applicants' independent claim 25 which states the step of sending, by the client device, the user data to the service provider because there is no communication path described in Hendrey from the mobile unit to the store. And further, Hendrey does not make obvious Applicants' dependent claim 37 wherein the unsolicited, formatted advertising information received in the client device from a transmitter outside the client device includes contact information containing instructions enabling the client device to communicate with the service provider because the mobile unit of Hendrey does not communicate with the store, which, as described in Hendrey, is the equivalent of Applicants' claimed service provider. For the same reasons, and with respect to dependent claims 10 and 13,

Hendrey does not make obvious Applicants' claimed executable code received in the client device to allow the client device to interact with the service.

For the reasons stated above, and with respect to independent claim 29, Hendrey does not make obvious Applicants' claimed receiving an advertisement in the transmitter from a service provider and conveying the advertisement by the executable code in the transmitter to the client device because Hendrey does not describe the store's providing the advertisement to the stationary unit, nor does Hendrey disclose executable code in a transmitter. Hendrey alludes to advertising content's being provided by the store, but nowhere states how that happens. In fact, Hendrey teaches away from Applicants' claimed receiving the advertisement by the executable code in the transmitter from a service provider because Hendrey states that advertisements are "created" and "generated" by the advertising content generation subsystem 131. For these reasons, Hendrey cannot make obvious Applicants' claim 29.

With respect to dependent claims 27, 41, and 42, Applicants claim wherein the service provider data is displayed using a plug-in cooperatively associated with the service information, and wherein the plug-in further comprises information about a preference of the user. Hendrey does not make obvious Applicants' claimed plug-in cooperatively associated with the service information because no mention whatsoever is made in Hendrey about the use of a plug-in. Hendrey provides advertisements to users, but, in Hendrey, user preferences are determined by a profile processed by the location-sensitive advertising content generation subsystem that generates relevant advertising content (col. 4, lines 26-41), not by Applicants' claimed plug-ins that execute in the client device. Therefore, Hendrey cannot make obvious Applicants dependent claims 27, 41, and 42.

With respect to dependent claim 43, Applicants claim a method including the steps of displaying the service provider data on a wearable device and receiving user data from eye movement. Hendrey cannot make obvious Applicants' claimed step of receiving user data from eye movement because Hendrey makes no mention whatsoever of receiving user data, as stated previously, and because Hendrey makes no mention whatsoever of receiving user data from eye movement.

Applicants' dependent claims 14-18, 22-24, 38-40, 44, and 45 are not made obvious by Hendrey at least because they depend from independent claims 1, 19, 25, and 35 which are not

themselves made obvious by Hendrey for the reasons stated above. Also, with respect to Applicants' claims to protocol layers in the transmitter, Applicants respectfully point out that nowhere does Hendrey disclose or suggest Applicants' claimed protocol layers, nor does Hendrey disclose or suggest Applicants' claimed compatibility between the emitter link layer in the transmitter and the client device link layer. As pointed out in *RF Protocol Design and Reconfigurable Logic Implementation for Low Power Applications*, Alvarez et al., Facultad de Informatica UPV/EHU, (2003) "some commercial transceivers include the physical and Media Access Control layers, . ,," but "other transceivers need all the protocol layers" . Without an explicit reference to an emitter link layer, or any protocol layer, Hendrey is lacking in these aspects of Applicants' claimed invention.

On pages 6, 10, 12, and 14, with respect to independent claim 1, and dependent claims 20, 30, and 36, the Office Action states that Hendrey fails to explicitly teach the use of XML elements, but that Weiss teaches a transcoding system for delivering electronic document to a device using multiple digital formats such as XML (Weiss, Abstract), and that it would be obvious to format the advertisement information into XML elements because it would offer greater flexibility in organizing and presenting information than is possible with other markup languages, such as HTML.

In the cited passage (Weiss, Abstract), Weiss states that a client, such as a handheld computer, that includes a Braille display, is coupled with a transcoder proxy to receive Braille format information and electronic documents, where the electronic documents are accompanied by formatting information that is created in the transcoder proxy. Weiss states that the transcoder proxy includes rule sets for converting incoming XML, HTML, Postscript (PS), and PDF documents to any one of several Braille formats. In other words, the document entering the transcoder proxy is formatted in, for example, XML, and the transcoder proxy converts it to another (non-XML) Braille format and transmits it to the client.

Firstly, Applicants assert that Weiss cannot be combined with Hendrey because Hendrey would not operate as intended. A combination of Weiss and Hendrey would include the tracking system of Hendrey, the client device of either Hendrey or Weiss, and the transcoder proxy of Weiss. Messages originating at the tracking system of Hendrey would have to be generated in one of the formats specified by Weiss (XML, HTML, PS, or PDF) to be understood by the

transcoder of Weiss. Hendrey puts no such limitation on its advertisements, but if Hendrey did limit advertisements to a particular format, no transcoder proxy would be needed. Further, when the advertisement reaches the transcoder proxy of Weiss, it is converted to a Braille format, which is not generally understood by mobile unit users. Thus, the user in Hendrey's system would not be able to read the advertisement and would thus not be inclined to enter the business with which the advertisement is associated. In other words, if Applicants' claimed XML is used, no transcoder proxy is necessary, and if the transcoder proxy of Weiss is used, the tracking system of Hendrey no longer works as intended. Thus, Weiss, when added to Hendrey, defeats the purpose of Hendrey, and therefore, Weiss and Hendrey together cannot be used to make obvious Applicants' independent claim 1, and dependent claims 20, 30, and 36.

Second, neither Hendrey nor Weiss, either separately or in combination, disclose Applicants' claimed formatting, outside the client device (in a transmitter), unsolicited advertising information into XML elements, and propagating the advertising information (including the XML elements) to the client because neither Weiss nor Hendrey perform Applicants' claimed step of formatting the advertisement into XML elements. Hendrey has no such formatting requirements or restrictions on information that it creates in its tracking system, and Weiss receives XML documents, but nowhere does Weiss generate them or format information into XML. Thus, Weiss and Hendrey, either separately or in combination, cannot make obvious Applicants' independent claim 1 and dependent claims 20, 30, and 36.

On page 11, with respect to independent claim 25 and dependent claim 26, and with respect to cited passage Hendrey, col. 5, lines 12-32,

(1) The Office Action states that Hendrey teaches a method including the step of creating, by the client device, an object-oriented service object from the service information (independent claim 25); and

(2) The Office Action states that Hendrey teaches a method including the step of displaying an icon associated with the service object (dependent claim 26).

In the cited passage (Hendrey, col. 5, lines 12-32), Hendrey states that a prospect is identified based on the location of the mobile unit and, optionally, profile data, and the location-sensitive advertising content generation subsystem creates a tailored advertising message based

on the location and sends it to the mobile unit. Hendrey states that the prospect is considered active and can respond to the advertisement.

Applicants claim creating, by the client device, an object-oriented service object from the advertising information and displaying an icon associated with the service object. Hendrey does not make obvious Applicants' claimed object-oriented service object created by the client because Hendrey discloses in the cited passage method steps that are accomplished outside of the mobile unit, namely, identifying a prospect, creating an advertisement, and sending the advertisement to the mobile unit. Nowhere in the cited passage does Hendrey disclose or suggest that the mobile unit creates Applicants' claimed service object, and nowhere does Hendrey disclose or suggest Applicants' displaying of an icon associated with the service object. Thus, Hendrey does not make obvious Applicants' independent claim 25 and dependent claim 26.

On pages 11 and 13, with respect to dependent claim 31, and with respect to the cited passage Hendrey, col. 4, lines 46-61, the Office Action states that Hendrey teaches wherein the advertisement includes information enabling a user of the client device to make a decision about the service provider, the decision being based on the service information; data entry information informing the user about utilizing a service offered by the service provider; and contact information containing instructions for enabling the client device to communicate with the service provider.

In the cited passage (Hendrey, col. 4, lines 46-61), Hendrey states that advertisements may be sent regarding complementary businesses or competing businesses, and that an advertising effectiveness database records instances of when an advertisement is followed a subsequent visit by the user of the mobile unit to the business associated with the advertisement.

Applicants claim contact information enabling the *client device* to communicate with the service provider. In the system of Hendrey, advertisements are sent to the mobile unit, but the mobile unit itself has no part in communicating with the business associated with the advertisement. It is up to the user of the mobile unit to travel into the business in order for the tracking system to record an effective advertisement in its database. Therefore, Hendrey cannot make obvious Applicants' claim 31 because the mobile unit of Hendrey does not communicate with the service provider. Note that Applicants infer from the totality of the Office Action that Applicants' claimed service provider is equivalent to Hendrey's store, not to Hendrey's tracking

system. As discussed previously, if the Office Action is equating Hendrey's tracking system to Applicants' claimed service provider, then nowhere does Hendrey disclose a transmitter that receives information from the service provider. Thus, under either interpretation, Hendrey cannot anticipate Applicants' claimed system and method.

On page 11, with respect to dependent claim 28, the Office Action states that Hendrey teaches wherein the plug-in further includes information about a preference of the user (Hendrey, Abstract). In the Abstract, Hendrey states that location information about a mobile transceiver is used to generate advertising content when a user approaches the location of a business, that the content is tailored to the user's preferences and the business, that the location of the user is monitored to track the effectiveness of the advertisement, for example, whether or not the user enters the business and/or makes a purchase. Elsewhere, Hendrey indicates that the content is tailored by a tracking system component, where the tracking system is a stationary unit separate from the mobile device used to track the location of the user (col. 4, liens 26-44). Applicants, on the contrary, claim displaying in the client device using a plug-in associated with the service information that includes information about user preferences. Thus, whereas preference decisions in Hendrey are made outside the mobile device, Applicants claim a plug-in that includes information about a preference of the user. Hendrey, therefore, cannot make obvious Applicants' dependent claim 28 because Hendrey does not disclose plug-ins at all, nor does Hendrey disclose preference information in the mobile unit such as Applicants' have claimed in the client device.

Since Hendrey and Weiss, either individually or in combination, do not teach or suggest each and every element of Applicants' independent claims 1, 19, 25, 29, and 35, and claims 2-18, 20, 22-24, 26-28, 30-34, and 36-45 which depend therefrom, Applicants' independent claims 1, 19, 25, 29, and 35, and dependent claims 2-18, 20, 22-24, 26-28, 30-34, and 36-45, are not made obvious by Hendrey and Weiss, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that independent claims 1, 19, 25, 29, and 35, and dependent claims 2-18, 20, 22-24, 26-28, 30-34, and 36-45, are now in condition for allowance. Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a) with regards to independent claims 1, 19, 25, 29, and 35, and dependent claims 2-18, 20, 22-24, 26-28, 30-34, and 36-45, for the reasons set forth above.

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Further, no rejection has been stated for dependent claim 34, and thus, Applicants assert that dependent claim 34 contains allowable subject matter.

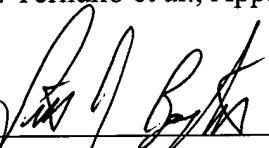
VI. CONCLUSION

Claims 1, 3-20, and 22-45 are believed to be in condition for allowance. All dependent claims depend upon allowable independent claims, and are therefore also believed to be in condition for allowance. In particular, there is no cited reference against dependent claim 34; Applicants therefore assert that dependent claim 34 contains allowable subject matter.

Although no new fees are anticipated, the Commissioner for Patents is authorized to charge additional fees or credit overpayment to Deposit Account No. 03-2410, Order No. 12078-142.

The following information is presented in the event that a call may be deemed desirable by the Examiner: Peter J. Borghetti (617) 854-4000

Respectfully submitted,
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Enclosures/